

REMARKS

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination can be made without serious burden.

The inventions of Groups I-VI are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. The inventions of Groups I-VI all relate to methods of diagnosing a thyroid condition and methods of determining whether subjects treated with thyroxine are receiving a proper dosage of thyroxine.

Applicants further assert that, at the very least, the Examiner has improperly restricted groups IV and V. Groups IV and V are directed to methods of determining whether a subject being treated with thyroxine is receiving a proper dosage, and of diagnosing a thyroid condition, respectively. Applicants note that each of groups I and VI, as the Examiner has formed them, encompass claims directed *both* to methods of diagnosing a thyroid condition *and* to methods of determining whether a subject treated with thyroxine is receiving a proper dosage. However, in forming groups IV and V, the Examiner has separated the claims directed to those two types of methods in a manner *inconsistent* with the formation of groups I and VI.

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Applicants therefore maintain that groups I-VI, and especially groups IV and V, are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Groups I-IV and VI would not require a serious burden once the prior art relevant to Group V has been identified. Therefore, there would be no serious burden on the Examiner to examine Groups I-VI together in the subject application. Hence, the Examiner must examine these Groups on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §121 and respectfully request that the Examiner reconsider and withdraw the requirement for restriction. Alternatively, applicants request that, at the very least, the Examiner reconsider and withdraw the request for restriction with respect to the claims of groups IV and V.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned

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attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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2/1/03
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